III. REMARKS/ARGUMENTS

A.   Status of the Application

Claims 1-15 are pending. Reconsideration of this application in light of the following remarks is respectfully requested.

B.   Rejections of Claims 1-9 under 35 U.S.C. §103(a)

Claims 1-9 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 5,241,533 to Kimoto et al. ("Kimoto '533"). This rejection is respectfully traversed.

Claim 1 is in independent form and is drawn to a method for transmission over packet networks including detecting, at a first node, at least one next node, creating a channel between the first node and the at least one next node, receiving, at the first node, a first packet, detecting a protocol of the first packet, merging the first packet with a second packet of the same protocol as the first packet, and transmitting the merged first packet and second packet to the at least one next node via the channel.

As the PTO recognizes in MPEP §2142:

> *The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.*

Further, 35 U.S.C. §103(a) provides that:

> *[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added).*

When evaluating a claim for determining obviousness, all limitations of the claim must be considered. MPEP §2143.03. In the present case, the Examiner cannot establish a *prima facie* case of obviousness because Kimoto '533, alone or in any combination, does not disclose the subject matter of claim 1 as a whole. The Examiner notes that Kimoto '533 does not specifically teach merging the first packet with a second packet of the same protocol as the first packet, and transmitting the merged first packet and second packet to the at least one next node via the channel, as set forth in claim 1. Kimoto '533 therefore fails to meet the requirements of

MPEP §2142 with respect to claim 1 because Kimoto '533 fails to teach, alone or in any combination, the subject matter of claim 1.

To overcome this shortfall, the Examiner states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to merge and transmit any number of packets, since merged packets provide an enhanced VOIP quality." However, MPEP §2144.03 requires that "assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art." The conclusory statement in the present Office Action fails to cite reference works in the pertinent art to support the assumption that merging the first packet with a second packet of the same protocol as the first packet, and transmitting the merged first packet and second packet to the at least one next node via the channel would have been obvious to one of ordinary skill in the art at the time the invention was made. Accordingly, the rejection under 35 U.S.C.§ 103(a) is not in compliance with the requirements of MPEP §2144.03.

Moreover, MPEP §2144.03 cautions that "[a]ny rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied." Applicant submits that the present case is not one where "judicious application" would permit the present assertion, due to the esoteric technical nature of packet switched computer networking, and that evidence must be provided that would show that it would have been obvious to merge the first packet with a second packet of the same protocol as the first packet, and transmit the merged first packet and second packet to the at least one next node via the channel.

Accordingly, Applicant respectfully submits that the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 1 under 35 U.S.C. §103(a) over Kimoto '533 should be withdrawn.

Each of claims 2-9 depends directly or indirectly from claim 1 and therefore each includes at least the same elements as its respective independent claim. Therefore, it is respectfully requested that the rejection of claims 1-9 under 35 U.S.C. §103(a) over Kimoto '533 be withdrawn.

C. Rejections of Claims 10-14 under 35 U.S.C. §103(a)

Claims 10-14 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 5,241,533 to Kimoto et al. ("Kimoto '533"). This rejection is respectfully traversed.

Claim 10 is in independent form and is directed to an internet trunking protocol node including a channel interface for assigning a channel to a next node, a port for transmitting and receiving a plurality of packets to and from the next node, a processor for performing instructions in response to received packets, and a memory, in communication with the processor, for storing a plurality of instructions, wherein the instructions include instructions, responsive to the receipt of a packet, for detecting a protocol of the packet, instructions for merging a plurality of packets of the same protocol into a merged packet, instructions for splitting a packet comprised of a plurality of packets of the same protocol, and instructions for routing packets according to an internet protocol.

As the PTO recognizes in MPEP §2142:

> The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

Further, 35 U.S.C. §103(a) provides that:

> [a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter _as a whole_ would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added).

When evaluating a claim for determining obviousness, all limitations of the claim must be considered. MPEP §2143.03. In the present case, the Examiner cannot establish a _prima facie_ case of obviousness because Kimoto '533, alone or in any combination, does not disclose the subject matter of claim 10 as a whole. The Examiner merely indicates that an "interface," "processor" and "port" are inherent, while neglecting the actual limitations recited in claim 10. For example, the Examiner has not shown that Kimoto '533 teaches "a channel interface for assigning a channel to a next node." For this reason alone, the rejection of claim 10 under 35 U.S.C. §103(a) over Kimoto '533 should be withdrawn.

Moreover, the Examiner states that claim 10 is rejected for the same reasons as discussed with respect to claim 1. However, as the Examiner acknowledged, Kimoto '533 does not teach

instructions for merging a plurality of packets of the same protocol into a merged packet, instructions for splitting a packet comprised of a plurality of packets of the same protocol, and instructions for routing packets according to an internet protocol, as set forth in claim 10. Kimoto '533 therefore fails to meet the requirements of MPEP §2142 with respect to claim 10 because Kimoto '533 fails to teach, alone or in any combination, the subject matter of claim 10.

To overcome this shortfall, the Examiner states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to merge and transmit any number of packets, since merged packets provide an enhanced VOIP quality." However, MPEP §2144.03 requires that "assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art." The conclusory statement in the present Office Action fails to cite reference works in the pertinent art to support the assumption that merging a plurality of packets of the same protocol into a merged packet, splitting a packet comprised of a plurality of packets of the same protocol, and routing packets according to an internet protocol would have been obvious to one of ordinary skill in the art at the time the invention was made. Accordingly, the rejection under 35 U.S.C. §103(a) is not in compliance with the requirements of MPEP §2144.03.

Moreover, MPEP §2144.03 cautions that "[a]ny rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied." Applicant submits that the present case is not one where "judicious application" would permit the present assertion, due to the esoteric technical nature of packet switched computer networking, and that evidence must be provided that would show that it would have been obvious to merge a plurality of packets of the same protocol into a merged packet, split a packet comprised of a plurality of packets of the same protocol, and route packets according to an internet protocol.

For these reasons, Applicant respectfully submits that the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 10 under 35 U.S.C. §103(a) over Kimoto '533 should be withdrawn.

Each of claims 11-14 depends directly or indirectly from claim 10 and therefore each includes at least the same elements as its respective independent claim. Therefore, it is

respectfully requested that the rejection of claims 10-14 under 35 U.S.C. §103(a) over Kimoto '533 be withdrawn.

D.   Rejection of Claim 15 under 35 U.S.C. §103(a)

Claim 15 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 5,241,533 to Kimoto et al. ("Kimoto '533"). This rejection is respectfully traversed.

Claim 15 is in independent form and is directed to a method for establishing voice communication over packet networks, the method including receiving an internet protocol packet at a node in communication with a plurality of nodes, splitting the internet protocol packet into a plurality of internet trunking protocol (ITP) packets, wherein each ITP packet of the plurality of ITP packets contains circuit-based information, for each of the plurality of ITP packets, determining a next node to which the ITP packet is to be transmitted, determining whether available bandwidth to the next node exceeds a predetermined threshold, assigning a channel to the ITP packet, and if there is a second ITP packet that is to be transmitted to the next node, merging the second ITP packet with the ITP packet.

As the PTO recognizes in MPEP §2142:

> The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

Further, 35 U.S.C. §103(a) provides that:

> [a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added).

When evaluating a claim for determining obviousness, all limitations of the claim must be considered. MPEP §2143.03. In the present case, the Examiner cannot establish a prima facie case of obviousness because Kimoto '533, alone or in any combination, does not disclose the subject matter of claim 15 as a whole. The Examiner merely indicates that an "interface," "processor," and "port" are inherent, while neglecting the actual limitations recited in claim 15. For example, the Examiner has not shown that Kimoto '533 teaches "internet trunking protocol

(ITP) packets." For this reason alone, the rejection of claim 15 under 35 U.S.C. §103(a) over Kimoto '533 should be withdrawn.

Moreover, the Examiner states that claim 15 is rejected for the same reasons as discussed with respect to claim 1. However, as the Examiner acknowledged, Kimoto '533 does not teach splitting the internet protocol packet into a plurality of internet trunking protocol (ITP) packets, and if there is a second ITP packet that is to be transmitted to the next node, merging the second ITP packet with the ITP packet, as set forth in claim 15. Kimoto '533 therefore fails to meet the requirements of MPEP §2142 with respect to claim 1 because Kimoto '533 fails to teach, alone or in any combination, the subject matter of claim 1.

To overcome this shortfall, the Examiner states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to merge and transmit any number of packets, since merged packets provide an enhanced VOIP quality." However, MPEP §2144.03 requires that "assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art." The conclusory statement in the present Office Action fails to cite reference works in the pertinent art to support the assumption that splitting the internet protocol packet into a plurality of internet trunking protocol (ITP) packets and, if there is a second ITP packet that is to be transmitted to the next node, merging the second ITP packet with the ITP packet would have been obvious to one of ordinary skill in the art at the time the invention was made. Accordingly, the rejection under 35 U.S.C. §103(a) is not in compliance with the requirements of MPEP §2144.03.

Moreover, MPEP §2144.03 cautions that "[a]ny rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied." Applicant submits that the present case is not one where "judicious application" would permit the present assertion, due to the esoteric technical nature of packet switched computer networking, and that evidence must be provided that would show that it would have been obvious to split the internet protocol packet into a plurality of internet trunking protocol (ITP) packets and, if there is a second ITP packet that is to be transmitted to the next node, merge the second ITP packet with the ITP packet.
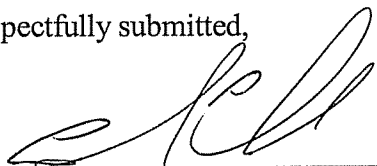
For these reasons, Applicant respectfully submits that the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 15 under 35 U.S.C. §103(a) over Kimoto '533 should be withdrawn.

IV. CONCLUSION

Claims 1-15 are now pending in the present application. In view of the foregoing remarks, allowance of claims 1-15 is respectfully requested. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

Date: ___1/8/09___

Andrew S. Ehmke
Registration No. 50,271

HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202 3789
Telephone: 214-651-5116
Facsimile: 214-200-0853
E-Mail: ipdocketing@haynesboone.com